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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hideaki Nishio

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NTT Mobile Communications Network I/BHGL

P.O. Box 10395

Chicago, IL 60610

EXAMINER

SIKRI, ANISH

ART UNIT

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2443

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,307	<b>Applicant(s)</b> NISHIO ET AL.	
	<b>Examiner</b> ANISH SIKRI	<b>Art Unit</b> 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8,9,11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8,9,11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/30/09, 3/16/09</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Claims 2-7, 10, 12 are cancelled.

### ***Information Disclosure Statement***

The information disclosure statement submitted on 1/30/09, 3/16/09 been considered by the Examiner and made of record in the application file.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Claims state the use of "string the application" as there is no support for that in application, and it is not clear to a person skilled in the art on what is "string the application". And for Claim 15 and 16, it is not seen in the application about the uses of the telephone network.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-17 are rejected under 35 U.S.C. 112, second paragraph, as failing to comply with the written description requirement

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Regarding claims 14, and 16, the phrase "string the application" and for claims 15, and 17 the "communication not transparent from outside the telephone network" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Objections***

Claims are objected due the Claim 1, 9, 11, 13, 20 recites the limitation "capacity reference table" There is insufficient antecedent basis for this limitation in the claim. The capacity reference table is not clearly pointed to which table it is being used in the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 9, 11, 13-20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ober (US Pat 6,397,331), in view of Huges (US Pub 20050198239).

Consider Claim 1, Ober discloses storage area management method comprising: providing at an area management apparatus a capacity reference table in which identifications of applications and capacities necessary for storing applications are storable in relation to identifications of application providers (Ober, Col 1 Lines 55-63, Col 2 Lines 44-49, Claim 1, Ober discloses on how the device obtains extra

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memory/capacity to be able to run additional algorithms/programs in the memory): receiving at the area management apparatus from a communication terminal a request identifying an application (Ober, Col 2 Lines 55-59, Ober discloses on how application code can be transferred into the memory) using the capacity reference table (Ober, Col 2 Lines 35-54, Ober disclosed on how the additional memory is checked before application is downloaded into the memory space of the device), determining at the area management apparatus a capacity necessary for storing the application identified in the and transmitting at the area management apparatus to the communication terminal an execution instruction to the determined capacity in a storage area (Ober, Col 1 Lines 55-63, Col 2 Lines 44-49, Ober discloses on how the device obtains extra memory/capacity to be able to run additional algorithms/programs in the memory).

But Ober does not explicitly disclose the use of requesting download of an application from a server.

Nonetheless, Huges discloses the request of downloading an application (Ronning, [0008], [0051]).

Both Huges and Ober provide features related to device management and communication. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

Therefore it would have been obvious to use request to download files, taught by Huges, in the system of Ober, to provide data management and communication between the user and systems.

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Consider Claim 9 Ober discloses the communication terminal comprising a storage unit (Ober, Col 2 Lines 61-63) into which applications are downloadable (Ober, Col 2 Lines 55-59, Ober discloses on how application code can be downloaded into the memory):

a control program receiver configured to receive a control program from the content server which is sent from the content server in response to the download request (Ober, Col 1 Lines 55-63, Col 2 Lines 44-49, Claim 1, Ober discloses on how the device obtains extra memory/capacity to be able to run additional algorithms/programs in the memory); a capacity information requester executed by the control program to transmitting to an area management apparatus a request identifying an application to be downloaded (Ober, Col 2 Lines 55-59, Ober discloses on how application code can be downloaded into the memory), a capacity information receiver executed by the control program to receive from the area management apparatus information indicative of a capacity necessary for storing the application identified in the request (Ober, Col 1 Lines 55-63, Col 2 Lines 44-49, Claim 1, Ober discloses on how the device obtains extra memory/capacity to be able to run additional algorithms/programs in the memory); a space reserver executed by the control program to-reserve a space having the notified capacity in the storage unit (Ober, Col 2 Lines 49-50, Ober discloses on how the space is expanded based on authentication, Col 2 Lines 61-67, Ober discloses on how trusted algorithms are passed on to the device due to secure kernel extensions, and if it is not trusted algorithm, the space will not be reserved, thus disabling the process and enablement of the new application); and an



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application downloader executed by the control application to store the application downloaded into the reserved space in the storage unit (Ober, Col 1 Lines 55-63, Col 2 Lines 44-49, Claim 1, Ober disclosed on how the application is stored in the storage unit).

But Ober does not explicitly disclose the use of requesting download of an application from a server.

Nonetheless, Huges discloses the request of downloading an application (Ronning, [0008], [0051]).

Both Huges and Ober provide features related to device management and communication. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

Therefore it would have been obvious to use request to download files, taught by Ronning, in the system of Ober, to provide data management and communication between the user and systems.

Claim 11, has similar limitations as to claim 1, therefore it is rejected under the same rational as to claim 1.

Claim 13, has similar limitations as to claim 1, therefore it is rejected under the same rational as to claim 1.

Consider Claim 14, Ober discloses the storage area management method according to Claim 1, wherein the capacity necessary for string the application is indicative of a size of the application and a size of data to be used by the application (Ober, Col 1 Lines 55-63, Col 2 Lines 44-49, Claim 1, Ober discloses on how the device obtains extra memory/capacity to be able to run additional algorithms/programs in the memory).

Consider Claim 15, Ober disclosed a storage area management method according to claim 1, wherein the area management apparatus is operated by a telephone network (Huges, [0018], [0031]), and the area management apparatus receives the request through a communication not transparent from outside the telephone network (Huges, [0018], [0031]).

Consider Claim 16, Ober discloses the communication terminal according to Claim 9, wherein the capacity necessary for string the application is indicative of a size of the application and a size of data to be used by the application (Ober, Col 1 Lines 55-63, Col 2 Lines 44-49, Claim 1, Ober discloses on how the device obtains extra memory/capacity to be able to run additional algorithms/programs in the memory)

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Consider Claim 17 Ober-Huges discloses a communication terminal according to claim 9, wherein the area management apparatus is operated by a telephone network (Huges, [0018], [0031]), and the communication terminal effects a communication with the area management apparatus not transparent from outside the telephone network (Huges, [0018], [0031]).

Consider Claim 18, Ober-Huges discloses that the communication terminal according to claim 9, wherein the application is a shopping application (Ober, Col 1 Lines 55-63, Ober discloses algorithms which are to be installed on the devices).

Claim 19 has similar claim limitations as Claim 9, therefore it is rejected under the same rational as Claim 9.

Claim 20 has similar claim limitations as Claim 9, therefore it is rejected under the same rational as Claim 9.

Claims 8 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Ober (US Pat 6,397,331), in view of Huges (US Pub 20050198239) in view of Albanese et al (US 2006/0112188).

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Consider Claim 8, Ober-Huges discloses the storage area management method according to Claim 1, wherein the communication terminal is a mobile terminal (Ober, Col 2 Lines 47-49, Ober discloses that the mobile terminal can be a cellular phone), and wirelessly communicates with the area management apparatus (Ober, does not explicitly disclose that it can communicate wirelessly, but it refers to communication can be done via a telephone).

But Ober-Huges does not explicitly refer that the communication can be carried out wirelessly.

Nonetheless Albanese et al discloses that the communication can be carried out by a wireless communication (Albanese et al, [0090]).

Both Albanese and Ober-Huges provide features related to device management and communication. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

Therefore it would have been obvious to use mobile devices and wireless communication, taught by Albanese et al, in the system of Ober-Huges, to provide wireless communication between the user and systems.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 8-9, 11, 13-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH SIKRI whose telephone number is 571-270-1783. The examiner can normally be reached on 8am - 5pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anish Sikri  
a.s.

April 10, 2009

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2443